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10/505,148	01/12/2005	Paul A Cameron	118989-04313564	5706
20583	7590	10/25/2007	EXAMINER	
JONES DAY			COONEY, JOHN M	
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NEW YORK, NY 10017			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/505,148

Applicant(s)

CAMERON ET AL.

Examiner

John Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Applicant's arguments filed 8-3-07 have been fully considered but they are not persuasive.

Double Patenting

Applicant is advised that should claims 1 and 3-42 be found allowable, at least claims 1 & 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinches et al.(4,602,079) in view of Limerkens et al.(5,840,782).

Vinches et al. disclose preparations of polyurethane elastomers having good hydrolysis resistance based on the reaction of polyester polyols derived from the

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reaction of dimer fatty acids and other acids such as adipic acid with polyols such as diethylene glycol, polyisocyanate prepolymers prepared from isocyanates and the polyester polyols disclosed, and chain extenders, all employed for their reactive effects, wherein, further, elastomers prepared from isocyanate-terminated prepolymers based on the described polyester polyols are reacted with chain extenders in the presence of surfactants, catalysts, and additives to form shaped articles including shoe soles (see column 1 lines 25-31, column 3 line 23 – column 7 line 63, the examples, and the entire document). Vinches et al. provides for other carboxylic acid in amounts meeting the ratios of the claims, and provides for the inclusion of trimer contents to the degrees claimed (column 4 lines 54-55).

Vinches et al. differs from the claims in that microcellular foam formation is not particularly recited. However, Limerkens et al. recites employment of water at time of reaction in the making of related polyurethane microcellular foams used in shoe soling applications for the purpose of imparting the foaming effect (see column 3 line 65 – column 4 line 24, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed water in the manner taught by Limerkens et al. in the preparation of the articles of Vinches et al. for the purpose of imparting cushioning and weight reducing effects to the articles realized in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

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Applicants' arguments have been considered. However, rejection is maintained.

The following arguments set forth previously are maintained:

Applicants' arguments have been considered but are unpersuasive and the rejection is maintained for the reasons set forth above. It is maintained that the references are properly combined for the reasons set forth above, and it is maintained that a prima facie case of obviousness has been established.

That the primary reference discloses provisions for the presence of some degree of water does not negate or overcome the rejection as set forth above. The secondary reference is looked to for teachings of means for enacting foaming in polyurethane elastomers to form microcellular foam structures. Whether the amounts of water included/allowed for in the preparations of Vinches et al. leads to formation of microcellular foam structures to some degree is not an issue set forth by the examiner in light of the fact that Vinches et al. is silent as to microcellularity and other cell structures in the articles of their invention. However, this disclosure of Vinches et al. does not negate the combinability of Vinches et al. with a reference which goes into the microcellular foam structure arising from the use of water and other blowing agents and the controls of density associated with their use.

Applicants' recitation of tensile strength retention values in their claims has been considered. However, based on difference in the make-up of the compositions claimed over those of Vinches et al. not being established, it is seen that these physical characteristics are qualities which would be possessed by the compositions disclosed by Vinches et al. Accordingly, such features of the claims are not seen to be differences under 35 USC 103. This recitation in the claims does not relieve applicants of their burden to demonstrate new or unexpected results attributable to the differences indicated in the rejection above which are commensurate in scope with the scope of the claims as they currently stand. At this time a sufficient showing of new or unexpected results has not been made evident.

Result Must Compare to Closest Prior Art:

Where a definite comparative standard may be used, the comparison must relate to the prior art embodiment relied upon and not other prior art – *Blanchard v. Ooms*, 68 USPQ 314 – and must be with a disclosure identical (not similar) with that of said embodiment: *In re Tatincloux*, 108 USPQ 125.

Results Must be Unexpected:

Unexpected properties must be more significant than expected properties to rebut a prima facie case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

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In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

Claims Must be Commensurate With Showings:

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to overcome a reasonable case of prima facie obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Applicants' have not persuasively demonstrated unexpected results for the combinations of their claims. Comparisons have not been related to the prior art embodiment relied upon. Applicants have not demonstrated their results to be clearly and convincingly unexpected and more significant than being secondary in nature. Applicants' showings are not commensurate in scope with the scope of combinations now claimed.

As to the amount values of claims 35-36, these are values contained in or close in overlap with other claims of applicants' invention and are addressed in the rejection and arguments above.

As to applicants' employment of the language "consisting essentially" in the claims, the following is held:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants' specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics.). "A consisting essentially of" claim occupies a middle ground between closed claims that are written in a consisting of format and fully open claims that are drafted in a comprising format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 998). See also *Atlas Powder v. E.I. duPont de*

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Nemours & Co., 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); In re Janakirama-Rao, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); Water Technologies Corp. vs. Calco, Ltd., 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also AK Steel Corp. v. Sollac, 344 F.3d 1234, 1240-41, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003) (Applicant's statement in the specification that "silicon contents in the coating metal should not exceed about 0.5% by weight" along with a discussion of the deleterious effects of silicon provided basis to conclude that silicon in excess of 0.5% by weight would materially alter the basic and novel properties of the invention. Thus, "consisting essentially of" as recited in the preamble was interpreted to permit no more than 0.5% by weight of silicon in the aluminum coating.); In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989) ("Although consisting essentially of is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . . [I]t is an applicant's burden to establish that a step practiced in a prior art method is excluded from his claims by consisting essentially of language.").

Applicants have not met their burden of showing the showing that the introduction of additional components of Vinches et al. would materially change the characteristics of applicant's invention to the degree required by M.P.E.P. 2111.03, and examiner maintains that for the purposes of searching for and applying prior art under 35 U.S.C. 103, absent a clear indication in the specification or claims of what the basic

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and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

Further, distinction based on the single polyester defined by the claims is not seen to be evident based on the teachings of prior art, nor is limitation to exclude other materials and/or polyesters beyond the defined polyesters of the claims reflected by the limitations of the claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

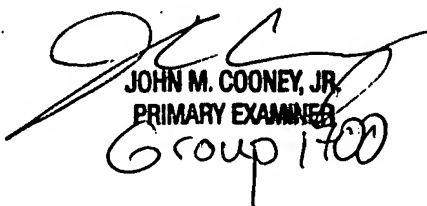
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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